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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,996	03/13/2001	Hiroiyuki Sekihata	1095.1170/JDH	9371

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EXAMINER

KRAMER, JAMES A

ART UNIT	PAPER NUMBER
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3692

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/803,996	<b>Applicant(s)</b> SEKIHATA ET AL.	
	<b>Examiner</b> James A. Kramer	<b>Art Unit</b> 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,6-10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6-10 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>Sept. 13, 2006</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/14/06 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epixtech in view of Saito et al (JP 11-110441) and Google Groups Printout.

As to claims 1 and 12, Epixtech shows book stock information management means and software; bibliographic information management means and software (see e.g., Dynix Features – personal bibliographies); loan information management means

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and software (see e.g., circulation features of Dynix, Horizon); order information management means and software capable of managing information on books ordered by individual libraries and ordering means and software capable of ordering based on the managed information; and a loan reserving means and software (e.g., Dynix Technical Services – Acquisitions and Electronic Ordering; Horizon Technical Services – Acquisitions – serial links)(it is noted that this is shown on p. 2 of the Horizon printout which is out of order and is the last page of the document). It further shows that the loan information management means and software enable a library to modify the loan information of another library since it checks books in and out on interlibrary loan and enters their status and since all data lending and borrowing information are maintained in a single database (see e.g., press release—p.2, 1<sup>st</sup> par., Dynix and Horizon).

Epixtech does not explicitly show collation information receiving means or software capable of receiving collation information from the individual libraries, the collation information containing library identifiers; collation information transmitting means or software capable of transmitting the collation information to the vendor; that the order information management means and software and ordering means and software are capable of dealing with ordering information from individual libraries; or that the loan reserving means is capable of reserving a book that is ordered but not yet delivered.

Saito shows means and software capable of receiving the claimed collation information comprising the central processing unit which is networked to the branches and means capable of transmitting the collation information to the vendor (see e.g., Fig.

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1) and order information management means and ordering means capable of handling orders from individual libraries. It would have been obvious to one of ordinary skill in the art to further modify the apparatus and software of Epixtech by adding the elements of Saito in order streamline the ordering process and to track and close out the fulfillment process.

Google (p. 7/10) shows a loan reserving means capable of reserving a book that is ordered but not yet delivered. It would have been obvious to one of ordinary skill in the art to further modify the apparatus and software of Epixtech in order to allow patrons to browse information about upcoming titles and receive them soon after they come out.

As to claim 6, Epixtech in view of Saito et al and Google show that the ordering means is capable of placing an order at a price reduced in accordance with an order quantity since the claim just recites that it places an order at a reduced price in accordance with a reduced price and does not claim that it determines the reduced price based on a quantity. Since the system is capable of placing an electric order, any amount can be entered, including a reduced price.

Alternatively, Epixtech in view of Saito et al and Google show all elements of claim 6 except placing an order at a reduced price based on quantity. However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of Epixtech by placing an order at a reduced price based on quantity in order to save money.

As to claim 8, Epixtech in view of Saito et al and Google show statistical information generating means (e.g., Resource Sharing System, 5<sup>th</sup> paragraph; Executive Information System).

As to claim 9, Epixtech in view of Saito et al show and Google request receiving means, searching means, and result transmitting means.

As to claim 10, Epixtech in view of Saito et al and Google show all elements except SDI keyword registration means and new information sending means. However, the examiner takes official notice that it is notoriously old and well known in the art to register a SDI keyword and receive information when a new book corresponding to that keyword is registered. It would have been obvious to one of ordinary skill in the art to do so in order to provide the user with relevant information automatically, saving labor.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Epixtech in view of Saito et al and Google as applied to claim 1 above, and further in view of Rubin et al (6,078,897).

Epixtech in view of Saito et al and Google show all elements of the claim except a reduced price estimating means for estimating a reduced price. Rubin et al show a reduce price estimating means. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of Epixtech by using the discount estimator of Rubin et al in order more easily facilitate the use of volume discounts.

***Response to Arguments***

Applicant's arguments filed 8/14/06 have been fully considered but they are not persuasive.

Applicant asserts that the cited prior art fails to teach a loan reserving means capable of reserving a book that is ordered but not yet delivered. Applicant correctly notes that Google Groups Printout is relied upon to teach this feature. Applicant asserts that "Google Groups Printout merely discusses preferences for purchasing books or borrowing books from a library. The Google Groups Printout merely discusses that a user can browse bookstores or search the Internet to determine release dates and titles of upcoming books. Once a user has determined the titles of these upcoming books, a user must log into a library computer system to place holds on the desired titles." Examiner does not disagree with this description of Google Groups Printout.

Further, Examiner does not believe that this teaching is inconsistent with the language of the claims. In particular, Google Groups Printout includes the user logging into the library system and putting the book on hold. If the book placed on hold is "on order" then the book is registered as a "loan reserved and unavailable book when the book is request is not yet delivered."

Once again, it is the Examiner's position that there is nothing inconsistent with the user first searching for books they desire on the Internet or at a bookstore prior to using the library system.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (571) 272 6783. The examiner can normally be reached on Monday - Thursday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272 6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer  
Primary Examiner  
Art Unit 3627

A handwritten signature in black ink, appearing to read 'James A. Kramer', with a large, stylized loop at the end.

JAK  
11/2/06